

R E M A R K S

A. INTRODUCTION

Claims 1-58 are pending and rejected.

Upon entry of this Amendment:

- Claims 2-58 will be pending
- Claims 2, 6, 44, and 56 will be amended
- Claim 1 will be cancelled without prejudice

B. AMENDMENT TO THE SPECIFICATION

The specification has been amended to correct a minor typographical error regarding the serial number of the second related application. No new matter has been added.

C. SECTION 103(A) REJECTIONS

Claims 1, 2, 6, 7, 44, 49, 56 and 57 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cole (U.S. Patent No. 5,850,217), and further in view of Schreadley (U.S. Patent No. 5,887,903) and in further view of Wilson ("Restaurants Offering Own Tips On How Much To Give Waiter").

Claims 3-5, 8-43, 45-48, 50-55 and 58 stand rejected as being unpatentable over Cole and in view of Schreadley and further in view of Wilson and further in view of Schultz (U.S. Patent No. 6,233,564).

We respectfully traverse the Examiner's Section 103(a) rejections.

1. Claims 1-5

Claim 1 has been cancelled without prejudice by this Amendment. Claims 2-5 depended (directly or indirectly) from independent Claim 1. Claims 3-5 depend from Claim 2, now rewritten as independent. The scope of Claim 2 has not been changed; accordingly, any new grounds of rejection will not have been necessitated by this Amendment. The findings with respect to some features of now cancelled independent Claim 1, which were incorporated by reference and are now explicitly recited in Claim 2, are discussed below.

With respect to independent Claim 1, the Office Action acknowledges that neither Cole nor Schreadley teaches "providing an offer." Applicants submit that neither Cole nor Schreadley teaches or suggests

determining an offer based on the received request

transmitting the offer for output to the customer on a record of charge

receiving an acceptance of the offer by the customer on the record of charge

providing a benefit to the customer after receiving the acceptance

as recited in independent Claim 1.

The Office Action includes a finding that

Wilson teaches providing an offer that allows customers to check a box for the desired tip, thereby outputting on the record of charge an indication of acceptance (See Full Text). This provides a benefit to the customer in that the tip is paid without the customer having to perform the calculation.

[Office Action, page 3]. Applicants agree that Wilson teaches calculating one or more “gratuity guidelines” or suggested tips, and including such calculated tips on a check. As a result of putting the calculated tip on the check, Wilson, however, cannot suggest indicating the amount of a calculated tip after receiving the acceptance.

If, on the other hand, the Examiner is making a finding that Wilson teaches calculating a total (including a suggested tip amount) “without the customer having to perform the calculation,” Applicants respectfully disagree. Wilson is silent as to how any total amount is calculated, or who calculates it, if a customer selects a particular suggested tip. Wilson states:

At Lula in Santa Monica, for instance, checks come with a recommended tip of 15%, 18% or 20% of the meal’s cost. Customers, properly encouraged, can then check a box, once they get over the surprise.

Applicants note that the New York Times cited by the Examiner also makes a reference to the practice at Lula, but does not mention the “check a box” process and is similarly devoid of any hint of how a total bill is calculated (or who calculates it).

Applicants also note that it is not inherent in Wilson that a total amount that included a selected tip is calculated for the customer. It is not necessary that such a calculation be made for the customer. The customer, for example, could check a box to indicate a particular tip and still be required to calculate the total himself.

Accordingly, the asserted combination of Cole, Schreadley, and Wilson does not teach at least the feature of *providing a benefit to the customer after receiving the acceptance*. The Schulze reference does not correct this deficiency of the proposed combination of references.

Claim 2 includes the feature of: *in which the offer defines an obligation for the customer to fulfill in exchange for the benefit.*

With respect to Claim 2, the Office Action makes a finding:

Wilson teaches that the offer defines an obligation for the customer to fulfill in exchange for the benefit (See full text: Customer must pay more as an obligation).

Applicants respectfully disagree with this finding. Applicants respectfully submit that the asserted finding indicates the subject matter of Claim 2 was misconstrued and/or the subject matter was not considered as a whole.

Applicants accept that, generally, paying more may be interpreted as an “obligation.” The Office Action, however, also asserts that the offer of Wilson “allows customers to check a box for the desired tip,” and the benefit of Wilson is specifically that “the tip is paid without the customer having to perform the calculation.”

In stating that Wilson teaches the above specific feature of Claim 2, the Office Action therefore must be asserting that Wilson teaches: in which allowing a customer to check a box for a desired tip [the alleged *offer*] defines paying the tip [the alleged *obligation for the customer*] is in exchange for paying the tip (or paying the tip without having to perform the calculation) [the alleged *benefit*].

Applicants respectfully traverse this analysis. To the extent that the finding relies requires an interpretation of Wilson that the obligation and the benefit being identical (paying the tip), the finding is improper and cannot support a finding of obviousness of Claim 2. It would defy logic and common sense to suggest that any offer would require its obligation to be the same as its benefit. Wilson does not suggest defining an obligation for a customer to pay a tip in order to receive the benefit of paying the tip.

To the extent the finding relies on an interpretation that Wilson teaches paying a tip is an obligation to fulfill in exchange for a benefit of the customer not having to calculate the tip amount, that conclusion is erroneous and not supported by Wilson. The tip is calculated and included on the check without any corresponding obligation of the customer, and, in any event, the calculated tip is indicated prior to when the customer would pay the tip.

To the extent the finding relies on an interpretation that Wilson teaches paying a tip is an obligation to fulfill in exchange for not having to calculate the total bill, Applicants noted above that Wilson does not teach that customers do not have to calculate the total bill. But even if Wilson did so teach, it defies logic that if “paying more” or paying a tip would suggest an obligation to fulfill, the

corresponding benefit would be not having to calculate a total bill. For instance, the customer presumably would receive the same benefit (calculating the total) without paying any tip, and would receive the same benefit (calculating the total) regardless of how much he or she tipped. Nothing in Wilson remotely suggests that paying a tip is defined in an offer as an obligation to fulfill to receive a benefit of paying that tip without having to calculate the total bill.

For at least the above reasons, Applicants respectfully submit that no prima facie case of obviousness has been provided for any of Claims 1-5. Applicants respectfully request the Examiner's reconsideration and allowance of pending Claims 2-5.

2. Claims 6-50 and 56-58

Each of independent Claims 6, 44 and 56 has been amended and now provides for the feature of *in which the offer defines an obligation for the customer to fulfill in exchange for the benefit*, discussed above with respect to Claim 2 above. Applicants respectfully submit that Claims 6-50 and 56-58 contain allowable subject matter and the Examiner's reconsideration of those claims is kindly requested.

3. Claims 51-55

Claims 52-55 depend from independent Claim 51. Independent Claim 51 provides for a feature of *the offer to be presented to a customer during a transaction with a merchant, the offer specifying a product*. Nothing in the proposed combination of cited references teaches or suggests any such feature. Even if Wilson teaches "an offer" of a suggested tip, nothing in Wilson or Schultze (or the other references) remotely suggests presenting an offer specifying a product during a transaction with a merchant.

Further, with respect to Claim 55, the specific recited feature of *wherein the record of charge contains separate signature lines for the purchase amount and the offer* is not addressed in the Office Action. Nothing in the cited references remotely suggests such a feature. Various embodiments described in the Specification provide advantageously for multiple signature lines on a single record of charge, in which each corresponds, for example, to a different amount (e.g., one for a first amount to be charged if the offer is not taken, and one for a different amount to be charged and/or commitment to an obligation if the offer is taken).

For at least these reasons, Applicants respectfully submit that no prima facie case obviousness has been established for any of Claims 51-55. Applicants

respectfully request the Examiner's reconsideration and withdrawal of the Section 103(a) rejections of Claims 51-55.

D. ADDITIONAL COMMENTS

Our silence with respect to the Examiner's other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner's interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an un rebuttable prima facie case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner's assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

E. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We understand that a one-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$120.00

Deposit Account: 50-0271

Order No.: 99-012

Please credit any overpayment to the same account.

F. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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